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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,243	02/01/2000	Hideki Hyodoh	UTKO.002	5915

7590 07/11/2003  
Fulbright & Jawrski LLP  
600 Congress Avenue Ste 2400  
Austin, TX 78701

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 07/11/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/496,243

Applicant(s)

HYODOH ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) 37-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-27, 29-33, 35, 36, 67-86, 88 and 89 is/are rejected.
- 7) ☒ Claim(s) 17, 28, 34 and 87 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7-12, 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 37-66 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 14.

The disclosure is objected to because of the following informalities: Figure 50B is inaccurate since it shows segment 812 positioned farther from axis 810 than segment 814 at each location 816 rather than segments 812 and 814 being alternately being positioned further from axis 810 at each location 816 as the specification discloses on page 32, lines 12-13. Appropriate correction is required.

Claims 1, 2, 5, 7, 10, 11, 18, 20, 21, 24, 25, 27 and 67-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansen et al. (5,968,088) for the reasons set forth in paragraph 1 of the Office Action mailed Nov. 20, 2002. In addition, as to claim 68 as now amended, Hansen et al., in figures 3 and 4, show first and second segments 10, 11 alternating being farther from the axis at each crossing location 7 as broadly claimed. That is, at each crossing location 7, first and second segments 10, 11 twist around each other so that they are alternately spaced farther from the axis.

Claims 3, 4, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (5,968,088) in view of Rooney

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et al. (6,306,105) for the reasons set forth in paragraph 2 of the Office Action mailed Nov. 20, 2002.

Claims 6, 8, 9, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (5,968,088) for the reasons set forth in paragraphs 3 and 4 of the Office Action mailed Nov. 20, 2002.

Claims 18, 19, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (5,968,088) in view of Madrid et al. <sup>6,440,161</sup> (5,968,088) for the reasons set forth in paragraph 5 of the Office Action mailed Nov. 20, 2002.

Claims 12-16 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (5,968,088) in view of Thompson (6,019,786) for the reasons set forth in paragraph 6 of the Office Action mailed Nov. 20, 2002.

Claims 71, 77, 78, 80 and 81 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pulnev et al. (6,309,415). Pulnev et al. disclose a plurality of shape memory wires (elastic threads 1 noting col. 4, lines 21-23) woven together to form a body, an intersection of two wires crossed in non-interlocking fashion (since no interlocking is disclosed), where both ends 4 of the wires 1 are located proximate one end of the body. The term "proximate" or "near" is a relative term. Figure <sup>2</sup> 4 shows ends 4 located closer (or more proximate) to the right end than the left

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end of the body. Alternatively, assuming *arguendo* that Pulnev et al. fails to specifically disclose that the wires 1 cross in non-interlocking fashion, it is well known in this art to make woven stent wires cross in non-interlocking fashion in order to enable them to move relative to each other during expansion. It would have been obvious to make the Pulnev et al. wires 1 cross in non-interlocking fashion so that it too would have this advantage. As to claim 78, note col. 3, lines 58-62 of Pulnev et al.

Claims 72, 75, 76 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,309,415). As to claim 72, Pulnev et al. fail to disclose nitinol. However, it is well known in this art to use nitinol as material for stent wires in order to make the stent very elastic. It would have been obvious to make the Pulnev et al. stent wires nitinol so that it too would have this advantage. As to claim 75, Pulnev et al. fail to disclose the claimed wire diameter. However, it is well known in this art to make stent wires of a diameter within the claimed range in order to make the stent very elastic. It would have been obvious to make the Pulnev et al. stent wires of this diameter so that it too would have this advantage. As to claim 76, Pulnev et al. fail to disclose the number of wires as at least 6. However, it is well known in this art to use at least 6 stent wires in order to enable the stent to be effective in large body vessels. It would have been obvious to use at least 6 stent wires in the Pulnev

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et al. stent so that it too would have this advantage. As to claim 79, Pulnev et al. fail to disclose an hourglass shape. However, it is well known in this art to shape a stent in an hourglass shape in order to enable the stent to be effective in body vessels having a variable diameter. It would have been obvious to shape the Pulnev et al. stent in an hourglass shape so that it too would have this advantage.

Claims 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,309,415) in view of Rooney et al. (6,306,105). Pulnev et al. fail to disclose the claimed material. However, Rooney et al. teach that the claimed material is desirable in a surgical device apparently because it is strong and very elastic. It would have been obvious to make the Pulnev et al. stent wires of this material so that it too would have this advantage.

Claims 82-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,309,415) in view of Thompson (6,019,786). Pulnev et al. fail to disclose graft material. However, Thompson teaches that graft material should be attached to a stent apparently in order to increase its compatibility with the body. It would have been obvious to include graft material with the Pulnev et al. stent so that it too would have this advantage.

Claims 88 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,309,415) in view of Madrid et al. (5,968,088). Pulnev et al. fail to disclose the specific

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catheter construction. However, Madrid et al. teach that a catheter comprising a first and second tubes (figure 14) may be used to conveniently and accurately deploy a prosthesis. It would have been obvious to include such a catheter to deploy the Pulnev et al. prosthesis so that it too would have this advantage.

Claims 17, 28, 34 and 87 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed April 24, 2003 have been fully considered but they are not persuasive. The allegation that Hansen fails to disclose both ends of wire 10, 11 located proximate one end of the body is not well founded. Wires 10 and 11 are actually two portions of the same continuous wire as shown in figure 3 where wires 10 and 11 are shown merging together at eyelet 13. Further, the phrase "continue into each other" in col. 8, lines 33-34 indicate that wires 10 and 11 are continuous.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

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mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
July 9, 2003

  
MICHAEL THALER  
PRIMARY EXAMINER  
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